

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE PATENT APPLICATION OF:	Michael M. TSO
SERIAL NO.:	09/854,423
FILING DATE:	May 10, 2001
ATTORNEY DOCKET NO.:	031792-0311553
CONFIRMATION NO.:	7666
EXAMINER:	Thu Thao Havan
ART UNIT:	3695
FOR:	Using Currency to Purchase from Sellers that do not Recognize the Currency

**PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Final Office Action mailed **December 13, 2010** (hereinafter "Final Action"), Applicant requests a review of the Final Rejection in the above-referenced application. This request is being filed concurrently with a Notice of Appeal.

REMARKS

Claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 are pending in this application. Review is requested for the improper rejection of claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 under 35 U.S.C. § 103. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

The rejection of claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,061,660 to Eggleston *et al.* (hereinafter "Eggleston") in view of U.S. Patent No. 4,968,873 to Dethloff *et al.* (hereinafter

"Dethloff") is legally improper and should be withdrawn because the Examiner has failed to establish a *prima facie* case of obviousness.

In particular, assuming arguendo that that the proposed combination of Eggleston and Dethloff were deemed legally proper (which Applicant does not concede), the references, even if combined, still fail to disclose, teach, or suggest all of the claim features of at least independent claims 1, 15, and 29 for the reasons set forth in detail below.

A. EGGLESTON'S TELECOMMUNICATIONS CONNECTIONS (38) IS NOT AN INTERMEDIARY COMPUTER

Independent claim 1 includes positive recitations of an intermediary computer:

receiving, at an intermediary computer, from a client device associated with a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction, wherein the client device is operatively connected to the intermediary computer via a communications link, and wherein the first currency comprises a private currency;

decrementing, by the intermediary computer, an amount of the first currency associated with the first participant by decrementing a balance of a first currency account of the first participant maintained at the intermediary computer;

incrementing, by the intermediary computer, an amount of second currency associated with the first participant by incrementing a balance of a second currency account of the first participant maintained at the intermediary computer, wherein the second currency is recognized by the second participant;

The Examiner's rejection is predicated upon the erroneous assertion that the telecommunications connections (38) in FIG. 2 of Eggleston corresponds to Applicant's claimed intermediary computer [see Final Action, pg. 4]. In particular, the Examiner recites:

"An intermediary as claimed corresponds to a telecommunications connections in Eggleston since they are both a connection to link information between users."

[Final Action, pg. 4].

The Examiner's assertion that a telecommunications connection corresponds to a computer is neither a reasonable interpretation, nor is it consistent with the description of the intermediary computer in the as-filed Specification [see Applicant's *as-filed* Specification, e.g., pg. 7, lines 1-12, wherein "intermediary" and "communications link" are separate terms with different meanings]. For at least this reason alone, the rejection under § 103 is improper and should be withdrawn.

B. THE TELECOMMUNICATIONS CONNECTIONS (38) OF EGGLESTON DO NOT PERFORM THE CLAIMED OPERATIONS PERFORMED BY/AT THE INTERMEDIARY COMPUTER

Even assuming arguendo that the Examiner's interpretation were deemed proper, and that the telecommunications connections (38) of Eggleston do correspond to Applicant's claimed intermediary computer (which Applicant does not concede), the rejection would still fail as a matter of law.

Particularly, applying the Examiner's interpretation consistently to the claim language of independent claim 1, for example, the telecommunications connections (38) of Eggleston would have to perform the following claimed operations performed by/at the intermediary computer:

receiving, at an intermediary computer, from a client device associated with a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction, wherein the client device is operatively connected to the intermediary computer via a communications link, and wherein the first currency comprises a private currency;

decrementing, by the intermediary computer, an amount of the first currency associated with the first participant by decrementing a balance of a first currency account of the first participant maintained at the intermediary computer;

incrementing, by the intermediary computer, an amount of second currency associated with the first participant by incrementing a balance of a second currency account of the first participant maintained at the intermediary computer, wherein the second currency is recognized by the

second participant;

[See independent claim 1, (*emphasis added*)].

Eggleston's telecommunications connections (38) do not perform these claimed operations. Dethloff was not relied-upon for the teaching of the claimed intermediary computer. Because the Examiner's alleged § 103 rejection is based on portions of Eggleston alone that do not in fact support the Examiner's contentions, the Examiner has failed to meet the requisite burden of establishing a *prima facie* case of obviousness.

Independent claim 15 includes recitations similar to those of independent claim 1 addressed above. Independent claim 29 recites similar operations performed by/at a transaction processor (*e.g.*, decrement(ing) an amount of the first currency and increment(ing) an amount of second currency) that are not performed by Eggleston's telecommunications connections (38).

For at least the foregoing reasons, the rejection of independent claims 1, 15, and 29 under § 103(a) is improper and should be withdrawn. Dependent claims 3-9, 11-14, 17-23, 25-28, 31-37, and 39-41 are allowable because they each ultimately depend from an allowable independent claim, as well as for the further features they recite.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: March 14, 2011

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